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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,896	07/03/2003	Donald Alan Bistline	Donl	2965

7590 06/07/2005

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EXAMINER

GALL, LLOYD A

ART UNIT	PAPER NUMBER
3676	

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/613,896	Applicant(s) BISTLINE, DONALD ALAN	
	Examiner Lloyd A. Gall	Art Unit 3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 8, 10 and 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>07/03/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's election with traverse of Group I and the species of figs. 1-5 in the reply filed on January 18, 2005 is acknowledged. The traversal is on the ground(s) that the alternative use suggested in the Office action is not taught by the present application. This is not found persuasive because such alternative use does not need to be taught by the present application to be a proper restriction requirement. Provided an allowable generic claim is found with respect to the article claims 1-12, the non-elected species would also be allowable.

The requirement is still deemed proper and is therefore made FINAL.

Claims 8, 10 and 13-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on January 18, 2005.

Applicant should also note that in any future amendment filed by applicant, the text of the withdrawn claims must also be provided, even though the claims are considered to be withdrawn.

The disclosure is objected to because of the following informalities: The site listed on page 6, line 7 of the specification is objected to, and must be deleted.

Appropriate correction is required.

The drawings are objected to because reference numeral 604 in paragraph 0039 is not shown. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any

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amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claims 1-7, 9, 11 and 12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/685,662. Although the conflicting claims are not identical, they are not patentably distinct from each other because they substantially claim the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 7, 9, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by the PCT reference (660).

The PCT reference teaches an apparatus for mounting a surfboard to a vehicle, including a mounting bracket shown directly below the shackle 3 in figure 8, which mounting bracket receives the screws 14, 15, a mating unit 1 removably secured to the mounting bracket, the mating unit including an adjustable shackle 3, 7 and a mating portion 1, and a locking mechanism (2 or 5), and means 14, 15 for removably securing the mating portion 1 to the mounting bracket. The means 14, 15 includes a pin 14, 15 received in first 10 and second 11 apertures. The pins 14, 15 are inaccessible when the surfboard is installed. The mounting bracket as seen in figure 8 includes a rear planar surface which faces the vehicle, and opposite upper and lower side portions extending upwardly therefrom. Cushions 12 and 13 are also included. With respect to claim 12, it

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is noted that a snowboard is not positively being claimed, and that the PCT reference is capable of receiving a snowboard.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over the PCT reference (660) in view of Kemery et al.

Kemery teaches a shackle 10 for locking a snowboard. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute a snowboard for the surfboard of the PCT reference, in view of the teaching of Kemery, the motivation being to prevent theft of a snowboard when it is not in use.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the PCT reference (660) in view of Mareydt et al.

Mareydt teaches a slotted lower surface in element 15 of a mounting bracket to receive a tabbed lower surface of a mating unit 46. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include interengaging tab(s) and slot(s) with the mounting bracket and mating unit of the PCT reference, in view of the teaching of Mareydt, the motivation being to provide a strong connection there between.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the PCT reference (660) in view of Wroble.

It is noted that a fin removal mechanism and a fin are not being positively claimed, and that Wroble teaches a fin guard 350 in fig. 5B which is capable of covering a fin removal mechanism. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a fin guard with the shackle of the PCT reference, in view of the teaching of Wroble, the motivation being to prevent tampering and theft of a removable fin.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lloyd A. Gall whose telephone number is 571-272-7056. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

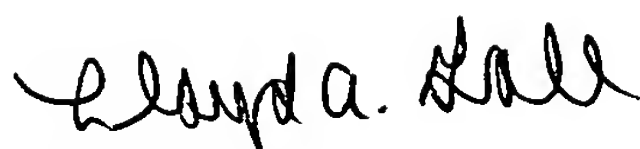
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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LG LG
May 26, 2005


Lloyd A. Gali
Primary Examiner